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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,148	03/31/2000	Peter T Fry	80934F-P	1747

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PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,148

Applicant(s)

FRY ET AL.

Examiner

Naeem Haq

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-17, 20-27, 30 and 40-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-17, 20-27, 30 and 40-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

New corrected drawings are required because this application has been filed with informal drawings which are acceptable for examination purposes only. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Response to Amendment

This action is in response to the Applicants' Request for Continued Examination (RCE) filed on November 24, 2004. The Amendment and Remarks filed on November 3, 2004 has been entered. Claims 1-7, 10-17, 20-27, 30, and 40-76 are pending and will be considered for examination. Applicants' amendments are sufficient to overcome the 112, second paragraph rejection of claims 1, 11, and 40 in the Final rejection dated August 31, 2004. This rejection is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 11, 21, 40, 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite "said service provider providing feed back to said user based on said meta data and/or said user using said software with respect to said low resolution digital image file." The specification does not describe or support an embodiment where both limitations are taken together. For this reason, this limitation lacks proper written description support.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 11, 21, 40, 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "said image" in line 6 of step b. It is unclear to the Examiner if this limitation is referring to the "high-resolution digital image" or to the "low-resolution image". For examination purposes, the Examiner will assume that this limitation is referring to the "low-resolution image". Claim 11 recites the limitation "said image" in line 5 of step a. It is unclear to the Examiner if this limitation is referring to the "high-resolution digital image" or to the "low-resolution image". For examination purposes, the Examiner will assume that this limitation is referring to the "low-resolution image". Claim 21 recites the limitation "said image" in

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line 3 of step b. It is unclear to the Examiner if this limitation is referring to the "high-resolution digital image" or to the "low-resolution image". For examination purposes, the Examiner will assume that this limitation is referring to the "low-resolution image". Claim 40 recites the limitation "said image" in lines 10 and 11 of the claim. It is unclear to the Examiner if this limitation is referring to the "high-resolution digital image" or to the "low-resolution image". For examination purposes, the Examiner will assume that this limitation is referring to the "low-resolution image". In addition, these claims recite the limitation "said user using said software on said server at said first location..." The Examiner notes that the claims also recite that the "server having software" is located at the *second location* and not at the first location. For this reason, it is unclear to the Examiner what the limitation "said user using said software on said server at said first location..." means when taken in context with the rest of the claim. Finally, these claims recite the limitations "...said server having software for manipulating and/or for ordering of goods..." and "said service provider providing feed back to said user based on said meta data and/or said user using said software with respect to said low resolution digital image file". These limitations are expressed in the alternative language, however the limitations are not equivalent. The Examiner notes that software for manipulating a digital image is not equivalent to software for placing an order. Likewise, a service provider providing feed back based on meta data is not equivalent to a user using software with respect to a low-resolution image file. For these reasons, claims 1, 11 are rendered indefinite.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1-7, 11-17, 21-27, 40-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoekstra et al. (US 6,304,277 B1) hereinafter referred to as Hoekstra.

Referring to claims 1-7, 11-17, 21-27, 40-76, Hoekstra discloses a method and system comprising the steps of: a user obtaining a low-resolution digital image file, a high-resolution digital image file, and associated meta data of an image (column 4, lines 7-31; Figure 1, item "10"; column 8, line 39-64; Figure 4, item "320"); transmitting said low resolution digital image file and said associated meta data which contains information about the digital image file by said user from a first location to a server at a remote image photoservice provider at a second location over said communication network, said server having software for manipulating said image file (column 2, line 33 – column 3, line 15; column 5, lines 23-28). Hoekstra does not teach that the meta data contains information about the high-resolution digital image file. However, the Examiner notes that this limitation is not functionally involved in the steps or elements of the recited method or system. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps and elements would be the same regardless of what information the meta data contained. The differences between the content of the Applicants' data and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms

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of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the meta data of Hoekstra because such information does not functionally relate to the steps or elements of the claimed method or system and because the subjective interpretation of information does not patentably distinguish the claimed invention. Hoekstra does not disclose that the user uses the software on the server at the first/second locations. However, Hoekstra discloses that it is well known in the art for an automated script file (i.e. software) at the second location to perform modifications on an image file (column 1, line 58 – column 2, line 5). Hoekstra further discloses that these automated script files fail to accurately correct all problems because not all files require the same corrections (column 2, lines 6-8). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the user edit the script file (i.e. use the software) at the second location. One of ordinary skill in the art would have been motivated to do so in order to allow the user to customize the script file to the particular characteristics of his or her individual image files. Hoekstra does not disclose transmitting the high-resolution digital image file after using the software for fulfillment of said goods or services. However, Hoekstra discloses that it is well known in the prior art to transmit a high-resolution digital image file for commercial purposes (column 1, lines 19-35; column 2, lines 18-23). Furthermore, Hoekstra discloses that once the high-resolution digital image file on the user's computer has been modified, it is "...then ready for use as

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desired." (column 6, lines 31-38). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the user in the invention of Hoekstra transmit the high-resolution digital image file to a second location. One of ordinary skill in the art would have been motivated to do so in order to allow the user to perform various commercial activities such as printing as disclosed by Hoekstra. Finally, Hoekstra discloses that the terms "high resolution" and "low resolution" are relative. Hoekstra discloses that the high resolution and low-resolution files referred to may vary greatly in size and in some instances overlap (low-resolution image is not greater than 200 x 150, where the high res is no less than 780 x 560, where low res is no greater than 50% of high resolution image) (column 4, lines 32-51).

Claims 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoekstra et al. U.S. Patent No. 6,304,277, as applied in claims 1, 11, and 21, in view of Hopkins U.S. Patent No. 6,282,462.

Hoekstra et al. does not explicitly disclose that the transmission of high-resolution image may be interrupted and resumed at the same place where transmission was interrupted. Hopkins shows a method for consistent transmission of image data preventing data loss (Col 3, Line 611. Given the unreliability of communications' networks it would have been obvious to modify the system of Hoekstra et al. to provide consistent transmission of image data, as taught by Hopkins, in order to maintain customer satisfaction and prevent any frustration involved at having to restart the image transmission process.

Response to Arguments

Applicant's arguments with respect to the claim limitation of forwarding metadata with regard to the high-resolution image file have been considered but they are not persuasive. The Examiner notes that the term "metadata" refers to any data that describes other data including how the data was formatted. The Examiner cites the reference "Computer & Internet Dictionary" to support this point. The reference provides a definition for the term "metadata" on page 344. Hoekstra discloses that the image file is compressed using a compression format such as JPEG, GIF, or LZW (column 4, lines 52-67; column 8, lines 39-64). Therefore, this compression format is a type of metadata since it describes how the data was formatted. Furthermore, it is inherent that this data is transmitted to the second location because otherwise the second location would not be able to decompress the file.

Applicant's arguments with respect to the claim limitation of allowing the user to use the software remotely at the service provider have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to the claim limitation of transmitting the high resolution digital image file to the service provider for fulfillment have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

February 21, 2005



WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600